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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,820	10/16/2003	Manny Manimtim Gabriel	GT1101	8485
20482	7590	08/25/2005	EXAMINER	
GARRISON ASSOCIATES 2001 SIXTH AVENUE SUITE 3300 SEATTLE, WA 981212522			STEIN, JULIE E	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,820

Applicant(s)

GABRIEL ET AL.

Examiner

Julie E. Stein, Esq.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. Figure 1a should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 19 is objected to because of the following informalities: two lines before the "whereby" clause, "the server" is recited, however, a plurality of servers is recited previously in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19 to 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 19 recites the limitation "the user" in the second to last line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 23, 25, 32, 34-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,611,516 to Pirkola et al.

9. Pirkola teaches all the steps of independent claim 23, including a method of receiving an SMS message from a sender in one wireless communication network and forwarding the SMS message to a recipient in another wireless communication network (abstract) comprising the steps of: (a) receiving an SMS message on a hardware device, located in the message sender's wireless network that is connected to the Internet and programmed to receive and forward SMS messages via wireless communications and the Internet (column 23, lines 26 to 52); (b) forwarding a message

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to a server device, via the Internet, that is programmed to receive and forward SMS messages via the Internet (Id.); (c) determining if the message is an SMS message from an authorized user (the Examiner takes Official Notice that it is well known in the art for a system to check the authorization of a user to thereby ensure the integrity of the system); (d) determining the SMS message recipient and the recipient's wireless communication network (column 23, line 26 to column 24, line 3); (e) forwarding the SMS message, via the internet, from the server device to a hardware device, located in the recipient's wireless communication network, that is connected to the Internet and programmed to receive and forward SMS messages via wireless communications and the Internet (column 24, lines 9 to 30); and (f) forwarding the SMS message to the desired recipient, via wireless communication, from the hardware device in the desired recipient's network (column 24, lines 26 to 30).

The rejection of 23 is hereby incorporated. Pirkola teaches all the steps of claim 32. The difference between claim 23 and claim 32 is that in step (e) the recipient is authorized to retrieve the SMS message from the server via an HTML based interface and in step (f) storing the SMS message until the recipient retrieves it. Pirkola teaches that an MS terminal (Figure 2, element 212) may be a computer connected to the mobile IP-telephony network through line 214, which may be the Internet. Therefore, one of ordinary skill in the art would have known at the time the invention was made that to obtain the SMS message would require that the SMS be retrieved via an HTML based interface as that is the most common interface used with the Internet. As for the SMS message being stored, one of ordinary skill in the art at the time the invention was

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made would have understood that if the SMS message was unable to be delivered, for example, because the user was not logged on to the Internet at the time, then the SMS message would be stored until the user retrieved it at a later time.

The rejections of claims 23 and 32 are hereby incorporated. Pirkola teaches all the steps of claim 35. The difference between claims 23 and 32, and 35 is that in step (a) the SMS message is received via an HTML based interface. As indicated above, Pirkola teaches that an MS terminal (Figure 2, element 212) may be a computer connected to the mobile IP-telephony network through line 214, which may be the Internet. Therefore, one of ordinary skill in the art would have known at the time the invention was made that a user could send the SMS message via an HTML based interface as it is the most common interface used with the Internet.

Pirkola also teaches all the steps of claims 25, 34 and 37, including the additional step of: notifying the sender after the message is successfully forwarded. See column 24, lines 31 to 41.

10. Claims 1-7, 9-14, 16-18, 24, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,611,516 to Pirkola et al. in view of U.S. Patent Application Publication No. 2005/0117602 to Carrigan et al.

The rejections of claims 23, 32 and 35 and their corresponding dependent claims are hereby incorporated. Pirkola teaches all the elements of independent claims 1 and 11 (which recites the same limitations, but with a plurality of elements) and dependent claim 2, including a system for sending and receiving SMS messages (abstract), comprising: at least one hardware device located in a first wireless communication

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network (Figure 2, elements 206, 230, and 208, MIPTN Visited Functions); the hardware device being connected to the Internet (column 6, lines 29 to 45); the hardware device being programmed to receive and forward SMS messages via the internet and via wireless communication (column 24, lines 34 to 41); at least one other hardware device located in at least one other wireless communication network (Figure 2, elements 274, CVF, which is the equivalent of the MIPTN Visited Functions); the hardware device being connected to the Internet (one of ordinary skill at the time the invention was made would have known that MS terminals in a cellular network, such as GSM (see column 5, line 66 to column 6, line 2) would be internet capable (see column 6, lines 29 to 55 and column 7, lines 34 to 60)); the hardware device being programmed to receive and forward SMS messages via the internet and via wireless communication (column 7, lines 20 to 33); at least one server device that is connected to the Internet (Figure 2, element 204, MIPTN Home Function); the server device being programmed to receive SMS messages from the hardware devices (Figure 17 and corresponding description) via the Internet (Figure 2, the MIPTN Home Function is located in a Mobile IP-Telephony Network), verify that the messages are SMS messages from authorized users of the system (the Examiner takes Official Notice that it is well known in the art for a system to check the authorization of a user to thereby ensure the integrity of the system), determine which hardware device to forward the SMS messages to (Figure 17 and corresponding description) and forward the SMS messages to the appropriate hardware devices via the Internet (Figure 17 and corresponding description).

However, Pirkola does not teach maintaining account information for debiting users of the system. But, Carrigan teaches a system of sending SMS messages between a PLMN and an IP Domain in which an IPG node, which translates the SMS messages, includes a billing/charging entity. See the abstract and paragraphs 96 to 101. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to include a billing/charging entity in the server of Pirkola as taught by Carrigan in order to manage the billing/charging of users who use the SMS service taught in Pirkola. See Carrigan, paragraphs 96 to 101.

Claims 1 and 11 further recite, whereby a user located in one wireless communication network, who desires to send an SMS message to a recipient in a different wireless communication network, can access the system via wireless communications to a hardware device in his or her wireless communication network and forward the SMS message to the hardware device, the hardware device will then forward the SMS message to the server device via the internet; the server device will then verify that the message is an SMS message from an authorized user, determine which other hardware device to forward the SMS message to and then forward the SMS message, via the internet, to the other hardware device in the desired recipients network; the hardware device in the desired recipient's network will forward the SMS message to the desired recipient via wireless communications (see above and Pirkola columns 23 to 27, which describes various methods of using the systems shown in Figures 2 and 17 to 23), the hardware device in the desired recipient's network will send a confirmation message (Pirkola column 24, lines 31 to 41) to the server device once

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the desired recipient has received the SMS message; and, the server device will then debit the user's account (Carrigan, paragraphs 96 to 101).

The Examiner notes that the "whereby" clauses found in a number of the independent claims do not positively recite claim limitations and thus are not given patentable weight even though the limitations have been addressed in this action.

Pirkola in view of Carrigan also teaches all the elements of claim 3, including wherein the hardware devices are cellular telephones connected to a computer. See Figure 2, elements 216 and 206 and 212.

Pirkola in view of Carrigan also teaches all the elements/ of claims 4 and 12, including wherein the hardware device is further programmed to assist the server device in determining which other hardware device to forward the SMS messages to, when such messages are received and forwarded by the system via wireless communication. See column 23, lines 27 to 52.

Pirkola in view of Carrigan also teaches all the elements of claim 5, including wherein the server device is a computer. The Examiner takes Official Notice that the MIPTN Home Function can be implemented via hardware (a computer) or software.

Pirkola in view of Carrigan also teaches all the elements of claims 6 and 13, including a plurality of user devices, the user device being computers that are programmed to communicate with the server device via the internet; and the server device is further programmed to communicate with the user devices via the Internet. See Figure 2 and corresponding description.

Pirkola in view of Carrigan also teaches all the elements of claims 7 and 14, including wherein the server device is further programmed to allow authorized users of the system to send SMS messages from a user device to the server device (see above), determine if the SMS message is to be forwarded to hardware device via the internet (see above), and forward the SMS message to the appropriate hardware device (see above), which will then forward the SMS message to the intended recipient via wireless communications (see above). See Figures 2 and 17-23, and corresponding descriptions.

Pirkola in view of Carrigan also teaches all the elements of claims 9 and 16, including wherein the server device is further programmed to store SMS messages and allow authorized users of the system to send and retrieve SMS messages via an HTML based interface on the Internet. See above.

Pirkola in view of Carrigan also teaches all the elements of claims 10 and 17, including wherein the server device is further programmed to forward SMS messages to wireless communications carriers and to receive SMS messages from wireless communications carriers, and forward the SMS messages received from the wireless communications carriers to the desired recipient. See Figure 2.

Pirkola in view of Carrigan also teaches all the steps of claims 24, 33, and 36, including the additional step of: debiting the account of the appropriate user after the message is successfully forwarded. See Carrigan, paragraphs 96 to 101.

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11. Claims 8, 15, 19-22, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirkola in view of Carrigan as applied to claims 1 and 11 above, and further in view of U.S. Patent Application Publication No. 2003/0119532 to Hatch.

Pirkola in view of Carrigan teach all the elements of claims 8 and 15 except wherein the server device is further programmed to forward SMS messages for authorized users of the system to the user's email account. However, Hatch teaches a method and system of sending a SMS message to an email account of a user. See abstract and paragraphs 6 to 9. Therefore, one of ordinary skill in the art at the time the invention was made would have modified the system and method of Pirkola in view of Carrigan in order to send an SMS message to a user's email account, if for example, a user was not in an area where their mobile phone was working. See *Id.*

The rejections of claims 1-18, 23-25, and 32-37 are hereby incorporated. Pirkola in view of Carrigan and further in view of Hatch teach all the elements of claims 19 and 26, which are a combination of the elements of the above claims, including the server devices forwarding the SMS message to a user's email account. See above.

Pirkola in view of Carrigan and further in view of Hatch teach all the elements of claim 20, which is similar as claim 12. See above

Pirkola in view of Carrigan and further in view of Hatch teach all the elements of claim 21, which is similar as claim 10. See above.

Pirkola in view of Carrigan and further in view of Hatch teach all the elements of claim 22, including wherein the server devices are further programmed to exchange

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information concerning SMS messages and user accounts via the internet. See Carrigan paragraphs 36, 45-50 and 96-101.

Pirkola in view of Carrigan and further in view of Hatch teach all the elements of claim 27, which is similar as claim 24. See above.

Pirkola in view of Carrigan and further in view of Hatch teach all the elements of claim 28, which is similar as claim 25. See above.

12. Claims 29 to 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirkola in view of Carrigan and further in view of U.S. Patent No. 6,819,932 to Allison et al.

The rejections of claims 1-15, 16-28 and 32-37 are hereby incorporated. Pirkola in view of Carrigan teach all the elements of claim 29 (claim 29 is a combination of the steps of the above claims), except receiving an SMS message, via an email, on a server device. However, Allison teaches a system and method of sending an email message, which forwards an SMS message to an SMSC. See Figure 2 and corresponding description. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Pirkola in view of Carrigan in order to add the functionality of sending an SMS message as an email message because it allows a computer terminal residing in a data network (internet) to send an SMS message. See column 3, lines 1 to 5.

Pirkola in view of Carrigan and further in view Allison teach all the steps of claims 30 and 31. See above.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,314,108 to Ramasubramani et al. teaches a method and system in which multiple carrier networks send and receive SMS messages to the internet; and U.S. patent Application Publication No. 2005/0083918 to Tian teaches a method and system of sending SMS messages between a CDMA network and a GSM network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES

Nguyen
8.22.2005

**NGUYENT.VO
PRIMARY EXAMINER**